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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,646	03/20/2006	Makoto Sameda	1000023-000102	4737

21839 7590 01/04/2008  
BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER	
REDDY, KARUNA P	

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
01/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	Application No. 10/572,646	Applicant(s) SOMEDA ET AL.	
	Examiner Karuna P. Reddy	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/11/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on 11/8/2007.

Applicants have amended claims 1-7. Claims 1-22 are currently pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 103***

3. Claims 1-3, 11-12, 16-17 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanishi et al (US 4, 265, 993) in view of Magome et al (US 2001/0028988 A1).

The rejection is adequately set forth in paragraph 4 of office action mailed 5/9/2007 and is incorporated here by reference.

4. Claims 4-7, 9-10, 14-15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanishi et al (US 4, 265, 993) in view of Magome et al (US 2001/0028988 A1) as applied to claims 1-3 above, and further in view of Ozaki et al (JP 05295123 A).

The rejection is adequately set forth in paragraph 5 of office action mailed 5/9/2007 and is incorporated here by reference.

5. Claims 8, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanishi et al (US 4, 265, 993) in view of Magome et al (US 2001/0028988 A1) as applied to claims 1-3 above, and further in view of Matsunari et al (US 5, 319, 337).

The rejection is adequately set forth in paragraph 6 of office action mailed 5/9/2007 and is incorporated here by reference.

### ***Response to Arguments***

6. Applicant's arguments, see page 7, lines 10-14, filed 11/8/2007, with respect to objection have been fully considered and are persuasive. The objection of claims 1-22 has been withdrawn.
7. Applicant's arguments filed 11/8/2007 have been fully considered but they are not persuasive. Specifically applicant's argue that (A) molecular weight, glass transition temperature and conditions for particle formation of present claims provide superior properties; (B) Magome et al disclose a polymerizable monomer and not a resin; and (C) specific conditions of spray drying as recited in present claim 7 is not disclosed by Ozaki et al.

With respect to (A), Kawanishi et al disclose a molecular weight of 38,000,  $T_g$  of 70°C while Ozaki et al teach a simple process for obtaining a composite particle. The discussion with respect to these features in paragraphs 4 and 5 of office action mailed 5/9/2007 is incorporated here by reference. The superior properties naturally flow from the combined teachings of Kawanishi et al, Magome et al and Ozaki et al.

With respect to (B), Magome et al discloses a magnetic toner comprising magnetic toner particles containing at least one binder resin (abstract). The paragraph 0020 cited by examiner in fact teaches that the polymerizable monomer is formed into a binder resin.

With respect to (C), specific conditions of spray drying i.e: inlet and outlet temperature of 100°C to 300°C and 40°C to 200°C respectively, of present claims overlaps with the inlet temperature of 80°C to 120°C and outlet temperature of 45°C to 80°C taught by Ozaki et al.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karuna P. Reddy whose telephone number is (571) 272-6566.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karuna P Reddy  
Examiner  
Art Unit 1796

/KR/

/Vasu Jagannathan/  
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